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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,702	12/29/1999	EVAN HOWARD LOTT		1341

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MARCUS G THEODORE, PC  
466 SOUTH 500 EAST  
SALT LAKE CITY, UT 84102

EXAMINER
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KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/473,702

Applicant(s)

LOTT, EVAN HOWARD

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/21/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 12-22 are presented for examination. Applicant filed a request for reconsideration of the rejection of claims 12-22 on 6/21/04 amending claims 12, 20 and 21. After careful consideration of Applicant's arguments, the Examiner maintains the rejection of claims 12-22 based on 35 USC 103 as set forth in detail below.

### ***Response to Arguments***

2. Applicant's arguments filed 6/21/04 have been fully considered but they are not persuasive. Applicant argues that the claims are not obvious over the prior art of record and specifically the Salt Lake Tribune Article does not disclose that the data in the databases do not have a cross indexing scheme, sorting and matching the non-corresponding sequences of insurance, driver and vehicle databases to generate a working database. The Examiner disagrees. The article clearly discloses that a database of uninsured motorists was created that compares state data from two sources, vehicle registration and driver licenses, with policy information provided by insurers. This characterization of the Insure-Rite database was described by an officer of the assignee of the instant application. Furthermore, a 9/28/2996 article in the Salt Lake City Tribune ("Uninsured-Motorists program to be Reviewed") characterizes the Insure-Rite system as combining and sorting data from driver-license data, motor vehicle registration information and auto-insurance information into a list of drivers who appear to have no insurance. None of the articles regarding the Insure-Rite system mention a cross indexing scheme or pre screening of data. The plain language of the

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articles with respect to the Insure-Rite system indicates that data is gathered from three sources, sorted and matched to produce a database of uninsured motorists. Applicant also states that the 1996 article discloses a system that was still experimental and could not have disclosed a perfected embodiment. However, the Examiner relies on information that was published in the articles. Finally, with respect to Applicant's arguments directed to the reliability of the system disclosed in 1996, the Examiner notes that the system was implemented at least by 1996 by the state of Utah as indicated by the articles. The system therefore was reliable enough for it to have been implemented and for articles describing the system to have been published. Therefore, Applicant's arguments directed to the rejection of claims 12-22 are not persuasive and the rejection of the claims is maintained.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett et al, Pat No. 5,325,291 and further in view of May, Jerrold, "A Hybrid system improves claims auditing at Blue Cross" and "Number of Uninsured Motorists Drivers Nose-Dives"(hereinafter Insure-Rite).

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As to claim 12, Garrett and May disclose the claimed limitations as discussed previously in Paper No. 12.

Garrett and May do not explicitly disclose data in the claimed databases do not have a cross indexing scheme; sorting and matching the non-corresponding sequences of insurance, driver and vehicle databases to generate a working database.

However, Insure-Rite discloses sorting and matching non-corresponding sequences of insurance, driver and vehicle databases, where the data is not cross-indexed, to generate a working database (i.e. database compares state data on vehicle registrations and driver licenses with policy information provided each month by all Utah insurers)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include sorting and matching non-corresponding sequences of insurance, driver and vehicle databases, where the data is not cross-indexed, to generate a working database as disclosed by Insure-Rite within Garrett and May for the motivation of reducing uninsured motorists on the highway (see page 1, first paragraph).

Claims 13, 15 and 16 have not been amended and are rejected for the reasons provided in Paper No. 8.

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5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett, May and Insure-Rite as applied to claim 12 above, and further in view of New York State Department of Motor Vehicles.

Claim 14 has not been amended and is rejected for the reasons set forth in Paper No. 8

6. Claims 17-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett, May and Insure-Rite as applied to claim 12 above, and further in view of Johnston, Michelle Dally, "State targets Scofflaw Drivers Database to reveal Who is Insured" (hereinafter Johnston).

Claims 17-18 have not been amended and therefore are rejected for the same reasons provided in Paper No. 8.

Claims 20 and 21 have been amended in substantially the same fashion as claim 12 and are rejected for substantially the same reasons as claim 12 above.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garret, May and Insure-Rite as applied to claim 12 above, and further in view of Bosco, Pat. No. 5,191,522.

Claim 19 has not been amended and is therefore rejected for the same reasons provided in Paper No. 8.

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8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett, May, and Insure-Rite as applied to claim 21 above, and further in view of Deppa et al., Pat. No. 5,732,198.

Claims 22 has not been amended and therefore is rejected for the same reasons provided in Paper No. 8.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. "Uninsured-Motorists program to be Reviewed" discloses a database of uninsured motorists.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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3/8/2004